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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,295

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Bernd Blanke

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EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

08/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,295	<b>Applicant(s)</b> BLANKE, BERND	
	<b>Examiner</b> CAITLIN FOGARTY	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/13/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1 – 14 are pending and presented for examination.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) was submitted on September 13, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

4. Claim 9 is objected to because of the following informalities: the examiner assumes based on the remaining claims and the instant specification that the composition of boron in claim 9 is a typographical error. It will be assumed that the content of boron in instant claim 9 is "where appropriate 0.0001 to 0.1". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112/101***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 – 4 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 – 4 and 14 are held to be indefinite because they merely recite a use without any active, positive steps delimiting how this use is actually practiced.

8. Claims 1 – 4 and 14 provide for the use of a precipitation-hardenable, martensitic, rustless chrome nickel steel, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1 – 4 and 14 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 9 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Stigenberg (US 5,512,237).

With respect to instant claim 9, col. 1 lines 17-34, col. 4 lines 14-51, and col. 4 line 66-col. 5 line 3 of Stigenberg anticipate the claimed precipitation-hardenable, martensitic, corrosion resistant (rustless) chrome nickel steel as seen in Table 1 below. See MPEP 2131.03.

Table 1

Element	Instant Claim 9 (weight %)	Stigenberg (weight %)	Overlapping Range (weight %)
Cr	10 – 14	10 – 14	10 – 14
Ni	7 – 11	7 – 11	7 – 11
Mo	0.5 – 6	0.5 – 6	0.5 – 6
Cu	0.5 – 4	0.5 – 4	0.5 – 4
Al	0.05 – 0.55	0.05 – 0.6	0.05 – 0.55
Ti	0.4 – 1.4	0.4 – 1.4	0.4 – 1.4
C + N	≤ 0.3	≤ 0.05	≤ 0.05
S	< 0.05	< 0.05	< 0.05
P	< 0.05	< 0.05	< 0.05
Mn	≤ 0.5	≤ 0.5	≤ 0.5
Si	≤ 0.5	≤ 0.5	≤ 0.5
Ti, Nb, V, & W	≤ 0.2 each	≤ 0.2 each	≤ 0.2 each
Co	≤ 9.0	≤ 9.0	≤ 9.0
B	0.0001 – 0.1	0.0001 – 0.1	0.0001 – 0.1
Fe + impurities	Balance	Balance	Balance

Stigenberg also teaches specific examples of the chrome nickel steel in Table 1 Alloy numbers 14 and 15 that are within the ranges recited in instant claim 9. The recitation in instant claim 9 that the steel is for use in the manufacture of machine-operated rotary tools is an intended use and does not further limit the structure of the steel. Therefore, it is not considered a claim limitation. See MPEP 2111.02 II.

Instant claims 10 – 13 recite intended uses of the steel and do not further limit the structure of the steel. Therefore, the recitations in instant claims 10 – 13 are not considered further claim limitations. See MPEP 2111.02 II.

***Claim Rejections - 35 USC § 102/103***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 5 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stigenberg (US 5,512,237).

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With respect to instant claims 5 and 8, col. 1 lines 17-34, col. 4 lines 14-51, and col. 4 line 66-col. 5 line 3 of Stigenberg teach the claimed precipitation-hardenable, martensitic, corrosion resistant (rustless) chrome nickel steel as seen in Table 2 below.

Table 2

<b>Element</b>	<b>Instant Claim 5 (weight %)</b>	<b>Stigenberg (weight %)</b>	<b>Overlapping Range (weight %)</b>
Cr	10 – 14	10 – 14	10 – 14
Ni	7 – 11	7 – 11	7 – 11
Mo	0.5 – 6	0.5 – 6	0.5 – 6
Cu	0.5 – 4	0.5 – 4	0.5 – 4
Al	0.05 – 0.55	0.05 – 0.6	0.05 – 0.55
Ti	0.4 – 1.4	0.4 – 1.4	0.4 – 1.4
C + N	≤ 0.3	≤ 0.05	≤ 0.05
S	< 0.05	< 0.05	< 0.05
P	< 0.05	< 0.05	< 0.05
Mn	≤ 0.5	≤ 0.5	≤ 0.5
Si	≤ 0.5	≤ 0.5	≤ 0.5
Ti, Nb, V, & W	≤ 0.2 each	≤ 0.2 each	≤ 0.2 each
Co	≤ 9.0	≤ 9.0	≤ 9.0
B	0.0001 – 0.1	0.0001 – 0.1	0.0001 – 0.1
Fe + impurities	Balance	Balance	Balance

In col. 1 lines 17 – 34, Stigenberg teaches that the chrome nickel steel readily lends itself to a variety of forming and fabrication operations such as straightening, cutting, machining, punching threading, winding, twisting, bending, and the like and may be used as a dental instrument or other medical instrument. Therefore, the cutting operation and dental and medical instruments inherently include machine-operated rotary tools as claimed. In the alternative, it would have been obvious to one of ordinary skill in the art to use the chrome nickel steel of Stigenberg to make a machine-operated rotary tool because the martensitic stainless steel of Stigenberg offers good ductility and good formability combined with high strength (col. 2 lines 27-32).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stigenberg (US 5,512,237).

Stigenberg is applied to instant claim 5 as discussed above in the 35 U.S.C. 102/103 rejection.

Stigenberg differs from instant claims 6 and 7 because it does not specifically teach that the machine-operated rotary tool has either geometrically or non-geometrically defined cutting edges. However, it is known in the art that machine-operated rotary tools may either have geometrically or non-geometrically defined cutting edges. Therefore, it would have been obvious to one of ordinary skill in the art to use the chrome nickel steel of Stigenberg to make machine-operated rotary tools having



either geometrically or non-geometrically defined cutting edges because of the excellent properties of the chrome nickel steel of Stigenberg.

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

CF

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